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**MAY 28 2004**

**OFFICE OF PETITIONS  
ON PETITION**

In re Application of  
Schubart et al.  
Application No.09/981,397  
Filed: October 16, 2001  
Attorney Docket No.AXM-004-14560

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed August 25, 2003 to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT.**

A petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR §1.76(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed applications.

The instant pending nonprovisional application was filed on October 16, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed provisional application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made unsigned oath or declaration present on filing.

The current procedure where a claim for priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim

for priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6).<sup>1</sup> In the instant case, the Office noted the claim for priority of the prior-filed application in the oath or declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$1300 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to the undersigned at (703) 305-1820. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 1646 for appropriate action on the amendment filed November 20, 2003, including consideration of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for benefit of the prior-filed application.



Brian Hearn  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> Note MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 09/98/397

2 Serial/Patent # 5/27/04

3 Please refund the following fee(s):

4 PAPER  
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17

8/28/03

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X No Fee Due (Explanation):

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